UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,351	02/06/2004	Douglas F. Reynolds	1033-LB1011	5256

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EXAMINER
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ART UNIT	PAPER NUMBER
2614	

NOTIFICATION DATE	DELIVERY MODE
07/09/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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PTOL-90A (Rev. 04/07)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>27 May 2008</u>.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
      closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-53</u> is/are pending in the application.
      4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) <u>1-53</u> is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
      Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
      Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
      a)☐ All   b)☐ Some * c)☐ None of:
          1.☐ Certified copies of the priority documents have been received.
          2.☐ Certified copies of the priority documents have been received in Application No. _____.
          3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
                application from the International Bureau (PCT Rule 17.2(a)).
      * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
      Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
      Paper No(s)/Mail Date. _____ .
5)☐ Notice of Informal Patent Application (PTO-152)
6)☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1.   A request for continued examination under 37 CFR 1.114, including the fee set

forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this

application is eligible for continued examination under 37 CFR 1.114, and the fee set

forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action

has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 27,

2008 has been entered.

Claim Rejections - 35 USC § 103

2.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

3.   The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1.   Determining the scope and contents of the prior art.
2.   Ascertaining the differences between the prior art and the claims at issue.
3.   Resolving the level of ordinary skill in the pertinent art.
4.   Considering objective evidence present in the application indicating
        obviousness or nonobviousness.

4.   This application currently names joint inventors. In considering patentability of

the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g)

prior art under 35 U.S.C. 103(a).

5.   **Claims 1-53** are rejected under 35 U.S.C. 103(a) as being unpatentable over

Koser et al. (US 2004/0032946 A1) in view of Cannon et al. (US 6,760,413 B2).

        Regarding **claim 1**, Koser discloses a call indication method [a flexible ring-tone

service, paragraph 0002] comprising:

        recognizing a request to complete a voice over Internet protocol call to a called

party [the Calling Party 20 calls a FlexRing subscriber at step S300, the FlexRing

Server 55 allowing provisioning to occur using a subscriber's CPE 25 over a VoIP

network, paragraphs 0113, 0117 and 0127);

        receiving custom ring information from a calling party of the VoIP call, the custom

ring information representing a desired ring tone to be played to the called party [If the

receiving party is a FlexRing subscriber, the SCP 23 generates a message to the

FlexRing Server 55 including information about both the calling party and the FlexRing

subscriber, step S402, and sends a custom message to the FlexRing Server 55

instructing the Server 55 to generate a ring-tone to the FlexRing CPE 25 for a call from the Calling Party 20, paragraphs 0120 and 0121]; and

initiating delivery of the custom ring information to the called party [The FlexRing Server 55 then streams the selected ring -tone to the FlexRing CPE 25 at step S308. The FlexRing Server 55 may stream the media from the Database 56 to the CPE 25, paragraph 0118].

Koser fails to disclose informing the calling party whether the custom ring information is being contemporaneously delivered to the called party.

However, Cannon teaches informing the calling party whether the custom ring information is being contemporaneously delivered to the called party [the calling party receives a download of data from the telephone central office 14 corresponding to the call related information regarding the called party using, e.g., FSK techniques between the first and second rings, column 4, lines 13-26].

Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Koser using the teaching of caller being informed of called party information as taught by Cannon.

This modification of the invention enables the system to inform the calling party that the information is being delivered to the called party so that the user would know the information is delivered, because the information of the called party is delivered while the called party phone is ringing.

Regarding **claim 2**, Koser discloses a call indication method, further comprising

utilizing a Public Switched Telephone Network node to perform at least one of the

recognizing step, the receiving step, and the initiating step (paragraph 0103).

Regarding **claim 3**, Koser discloses a call indication method, further comprising

recognizing that a piece of customer premises equipment associated with the called

party comprises specialized ring tone functionality operable to output the desired ring

tone (paragraph 0107).

Regarding **claim 4**, Koser discloses a call indication method, further comprising

delivering at least a portion of the custom ring information in VoIP packets (paragraph

0117).

Regarding **claim 5**, Koser discloses a call indication method, further comprising

delivering the custom ring information across a wireline connection comprising a link of

coaxial cable operable to carry data traffic (paragraph 0117).

Regarding **claim 6**, Koser discloses a call indication method, wherein a VOIP

switch initiates delivery of the custom ring information to the called party (paragraph

0117).

Regarding **claims 7 and 38**, Koser discloses a call indication method, further

comprising: prompting the calling party to communicate the custom ring information

(paragraph 0117); and

recording the custom ring information (paragraph 0117).

Regarding **claim 8**, Koser discloses a call indication method, further comprising

utilizing a piece of calling party CPE to perform at least one of the recognizing step, the

receiving step, and the initiating step (paragraph 0118).

Regarding **claims 9, 28 and 45**, Koser discloses a call indication method,

wherein at least a portion of the custom ring information has a file format selected from

the group consisting of a .WAV file, a .MIDI file, and an AU file (paragraph 0118).

Regarding **claims 10, 39, 52 and 53**, Koser discloses a call indication method,

wherein at least a portion of the custom ring information represents a spoken message

(paragraph 0120).

Regarding **claims 11 and 40**, Koser discloses a call indication method, wherein

recognizing the request to complete the VOIP call occurs after receiving the custom ring

information (paragraph 0118).

Regarding **claims 12 and 41**, Koser discloses a call indication method, further comprising storing the custom ring information in a memory residing in a piece of calling party customer premises equipment (paragraph 0107).

Regarding **claims 13, 37 and 42**, Koser discloses a call indication method, further comprising storing the custom ring information in a memory located within a service provider network (paragraph 0107).

Regarding **claims 14**, Koser discloses a call indication method, further comprising: recognizing caller identification information of the calling party (paragraph 0117); and

finding a location in the memory that is storing the custom ring information (paragraph 0117).

Regarding **claims 15, 34 and 49**, Koser discloses a call indication method, further comprising: recognizing another request to complete a second VOIP call to a second called party (paragraph 0117); and

determining that a second called party does not want to receive the custom ring information (paragraph 0117).

Regarding **claims 16, 35, 46 and 50**, Koser discloses a call indication method, further comprising blocking delivery of the custom ring information to the second called party (paragraph 0117).

Regarding **claims 17 and 36**, Koser discloses a call indication method, further comprising: receiving Caller Identification information associated with the second VOIP call (paragraph 0117); and

using the Caller Identification information to determine that the second called party does not want to receive the custom ring information (paragraph 0117).

Regarding **claim 18**, Koser in combination with Cannon discloses all the limitations of claim 18 as stated in claim 1's rejection above.

Regarding **claim 19**, Koser discloses a ring tone delivery system, wherein the network node comprises a VOIP switch operable to communicatively couple to a plurality of subscribers across links comprising twisted pair wiring (paragraph 0103).

Regarding **claim 20**, Koser discloses a ring tone delivery system, further comprising a memory maintaining information indicating that the called party has a piece of telephonic equipment capable of outputting the calling party selected ring tone, wherein the piece of telephonic equipment is selected from a group consisting of a computer, a telephone communicatively coupled to a twisted pair network, a cordless

telephone, a VOIP telephone, a cellular telephone, a fixed wireless telephone, and an

802.1 1 telephone (paragraph 0117).

Regarding **claim 21**, Koser discloses a ring tone delivery system, wherein the

network node is further operable to deliver packetized information across a cable

network (paragraph 0117).

Regarding **claim 22**, Koser discloses a ring tone delivery system, wherein the

network node is further operable to deliver packetized information across an XDSL

network (paragraph 0117).

Regarding **claim 23**, Koser discloses a ring tone delivery system, further

comprising a custom ring tone block list indicating that a second called party does not

want to receive the calling party selected ring tone (paragraph 0124).

Regarding **claim 24**, Koser discloses a ring tone delivery system, further

comprising a broadband modem providing at least a portion of a link communicatively

coupling the network node to a piece of telephonic equipment associated with the called

party (paragraph 0117).

Regarding **claim 25**, Koser discloses a ring tone delivery system, further

comprising a memory maintaining information indicating an additional communication

address for the called party, the additional communication address selected from the

group consisting of an electronic mail address, a Plain Old Telephony Service telephone

number, an Instant Messaging address, a Short Messaging Service address, an

Enhanced Messaging Service address, a Multimedia Messaging Service address, and a

wireless telephone number (paragraph 0118).

Regarding **claim 26**, Koser in combination with Cannon disclose all the

limitations of claim 26 as stated in claim 1's rejection above.

Furthermore Koser discloses an electronic device [paragraph 0117], a memory

[paragraph 0117], a user interface [paragraph 0117] and an output engine [paragraph

0118].

Regarding **claims 27 and 44**, Koser discloses a system, wherein the electronic

device comprises a computer (paragraph 0117).

Regarding **claim 29**, Koser discloses a system, wherein the memory stores

additional ring tone information representing a second select ring tone, further wherein

the select ring tone is associated with the called party and the second select ring tone is

associated with a different party (paragraph 0117).

Regarding **claims 30 and 47**, Koser discloses a system, further comprising an

electronic address book comprising a listing for the called party and a second listing for

the second party (paragraph 0117).

Regarding **claim 31**, Koser in combination with Cannon discloses all the

limitations of claim 31 as stated in claim 1's rejection above.

Regarding **claims 32 and 51**, Koser discloses a computer-readable medium

having additional computer-readable data to determine if the called party desires

delivery of the information (paragraph 0117).

Regarding **claim 33**, Koser in combination with Cannon discloses all the

limitations of claim 33 as stated in claim 1's rejection above.

Regarding **claim 43**, Koser in combination with Cannon disclose all the

limitations of claim 43 as stated in claim 26's rejection above.

Regarding **claim 48**, Koser in combination with Cannon disclose all the

limitations of claim 48 as stated in claim 1's rejection above.

Response to Arguments

6.   Applicant's arguments with respect to **claims 1-53** have been considered but are

moot in view of the new ground(s) of rejection.

Conclusion

7.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

>   Glasser et al. is cited for managing packet-based telephony.

>   Dement et al. is cited for implementing customized ringback.

8.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Gerald Gauthier whose telephone number is (571) 272-

7539. The examiner can normally be reached on 8:00 AM to 4:30 PM.

>   If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

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published applications may be obtained from either Private PAIR or Public PAIR.

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Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Gerald Gauthier
Primary Examiner
Art Unit 2614

/GG/
July 8, 2008